

reference) for a description of the teachings in EP 749,747. The Office acknowledges that the '517 reference does not specifically mention the viscosity of the disclosed composition, as recited in the present claims. See Office Action at 3. The Office, however, alleges that because the '517 reference "teaches the same polymers, solvents, stabilizers and other cosmetic ingredients in their composition [as claimed], the cosmetic compositions of [the '517 reference also] exhibit the same viscosity as claimed." *Id.*

Applicants respectfully disagree and challenge the allegation that the claimed viscosity range is "the same," e.g., inherent in the '517 reference merely because some of its components might be the same. The Federal Circuit has explained that "[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Continental Can Co. USA, Inc. v. Monsanto Co.*, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991); M.P.E.P. § 2112 ("[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.") (emphasis added).

This is true even if there is a disclosure of a family of compounds, some of whose members meet that limitation. For example, in *Akzo N.V. v. U.S. Int'l Trade Comm.*, the Federal Circuit affirmed a finding of no inherency from the mere disclosure of a compound. 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). The claim-at-issue in *Akzo* recited a method of manufacturing aramid fibers using 98% concentrated sulfuric acid. *Id.* The cited reference taught each element of the claim, including the use of sulfuric acid; however, the reference did not expressly teach the use of 98% concentrated

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sulfuric acid. *Id.* The Federal Circuit affirmed the Commission's finding "that concentrated sulfuric acid is not inherently 98% sulfuric acid to one skilled in the art." *Id.* (emphasis in original). Even though the term "sulfuric acid" encompasses "98% concentrated sulfuric acid," that is only a mere probability and not an inherent disclosure.

Similarly, in *Mehl/Biophile Int'l Corp. v. Milgram*, the Federal Circuit reversed a finding of inherency with respect to a process. 52 U.S.P.Q.2d 1303, 1306 (Fed. Cir. 1999). The claim-at-issue recited a method of hair depilation comprising a series of steps, including "aligning a laser light applicator substantially vertically over a hair follicle opening." *Id.* at 1305. The cited reference was a manual for the laser, explaining its use for removing tattoos. *Id.* at 1304. The court rejected Milgram's argument that a vertical alignment of the laser was inherent to the disclosure, saying "the possibility of such an alignment does not legally suffice to show anticipation . . . Occasional results are not inherent." *Id.* at 1306 (emphasis added). Hence, even though the laser is clearly either aligned or not aligned with the hair follicle, the mere possibility that it could be is not enough to apply the doctrine of inherency.

In *Ex Parte Viscardi*, the Board reversed an Examiner's finding of inherency with respect to an "effective amount" limitation. 136 U.S.P.Q. 382, 383 (Bd. Pat. App. & Int. 1963). The claims at issue were directed to a method of removing static electricity by the application of freshly evolved carbon dioxide in sufficient concentration to remove the static electricity. *Id.* The Board concluded that while the commercial gas tanks of the prior art reference (Catlin) would initially provide freshly-evolved carbon dioxide:

in the absence of appreciation by Catlin of the fact that carbon dioxide will remove a charge of static electricity, there is no reason

why. . . one skilled in the art following his teaching, should inherently adjust the concentration of carbon dioxide for the removal of the complete static charge. In short, the manipulative steps of this group of claims do not inherently result from the disclosure of the basic reference.

Id. Consequently, the disclosure of a compound without more is not an inherent disclosure with respect to an effective amount, only a mere possibility. In view of the foregoing, it is clear that in order to support the assertion that "the cosmetic compositions of EP exhibit the same viscosity as that claimed," the Office must find and articulate some justification in the prior art showing that the compounds of the '517 reference would always yield a composition with the viscosity properties of the claimed compound.

In this case, the Office cannot appropriately make this showing. Indeed, the Office admits that the '517 reference teaches "various formulations such as gels, milky dispersions, and oils, etc., which are different in their viscosities." Office Action at 3 (emphasis added). Thus, while the Office asserts that the claimed viscosity properties may be taught in the '517 reference, it also acknowledges that the broad formulations disclosed in the '517 reference would not necessarily and inevitably exhibit the claimed viscosity properties.

In addition, the '517 reference does not teach or suggest a range for the amount of polymer to be used, and thus certainly does not teach or suggest an amount that inevitably results in the claimed viscosity value. Furthermore, the '517 patent does not teach improved properties that are a function of the amount of polymer. The claimed invention, for example, illustrates that the use of 1.13% polymer (Example 2) produces a film that does not withstand rubbing as well as a composition that uses 2.23% polymer

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(Example 3). In fact, the '517 patent is merely concerned with, and thus primarily directed to, the development of a stable dispersion without suggesting any need for a certain amount of polymer or a desire to obtain a viscosity range when using that amount of polymer. See, e.g., col. 1, lines 29-32 ("The aim of the present invention is to propose a dispersion of particles which remain in the form of elementary particles, without forming agglomerates, when they are in dispersion in non-aqueous media.") One skilled in the art, therefore, would not have had any motivation to choose a particular amount of polymer for use with keratin fibers that result in the desired characteristics of the claimed invention.

For at least the foregoing reasons, the rejection is improper and should be withdrawn.

III. Rejection For Double Patenting

The Office maintains its rejection claims 1-31 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 5,945,095 to Mougin et al. ("Mougin") for the reasons of record. The Office contended that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims also recite a cosmetic composition, which is similar in scope of the instant claims." Office Action of March 4, 2002 at page 2. The Office also stated that even though Mougin does not specify a polymer percentage, "optimizing the amount of polymer depending on the desired form of the composition...would have been [obvious] for one of ordinary skill in the art." Office Action at 5.

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Applicants maintain the arguments of record and challenge the Office's assertion that optimizing the amount of polymer depending on the desired form of the composition would have been obvious. As is illustrated in Examples 2 and 3, Applicants found, surprisingly, that the amount of polymer used unexpectedly affects properties. For instance, the use of 1.13% polymer in Example 2 produced a film that does not withstand rubbing as well as a composition that uses 2.23% polymer in Example 3. For this reason, Applicants contend that the "optimizing" called for by the Office is not at all obvious, as the properties may be sensitive to small variations in polymer percentages.

Each of the claims of this application recites limitations regarding the weight percentages of the polymer and the viscosity of the composition. In contrast, the claims in Mougin fail to suggest, let alone recite, an analogous limitation. For this reason, the double-patenting rejection is improper and should be withdrawn.

IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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